

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MASTERCARD INCORPORATED AND
MASTERCARD INTERNATIONAL INCORPORATED,
Petitioner,

v.

OV LOOP, INC.,
Patent Owner.

IPR2023-01289
Patent 10,032,171 B2

Before JAMES A. TARTAL and BRENT M. DOUGAL, *Administrative
Patent Judges*.

TARTAL, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

I. INTRODUCTION

On October 3, 2024, we conducted a telephone conference with the Parties to discuss the following two contested issues raised by the Parties: (1) Mastercard Incorporated and Mastercard International Incorporated (“Petitioner”) seeks authorization to file a corrected version of Exhibit 1009 to address clerical errors in the version of the exhibit, as originally filed with the Petition (Paper 1, “Pet.”), and (2) OV Loop, Inc. (“Patent Owner”) seeks authorization to file a motion to strike portions of Petitioner’s Reply (Paper 26, “Reply”). For the following reasons, we *grant* Petitioner’s request for authorization to file a corrected version of Exhibit 1009 and *deny* Patent Owner’s request for leave to file a motion to strike portions of Petitioner’s Reply.

II. CORRECTION OF EXHIBIT 1009

Petitioner seeks to file a corrected version of Exhibit 1009, a publicly accessible U.S. provisional patent application (U.S. Provisional App. No. 61/619,095 (“the ’095 Provisional”)). Petitioner states that, when preparing its Reply, it first learned that Exhibit 1009, as filed with its Petition, included clerical errors with the formatting of figures appearing at pages 49 to 56. In particular, Figures 1 to 8 of Exhibit 1009 are truncated, resulting in images that show portions of the figures extending off of the page. Petitioner seeks to file a corrected version of Exhibit 1009 to include the full figures as they properly appear in the ’095 Provisional.

Patent Owner opposes Petitioner’s request. Patent Owner states that it learned of the formatting issues with Exhibit 1009 when recently informed by Petitioner. Patent Owner also states that, after learning of the issue, it was able to obtain the ’095 Provisional from the Office without the formatting issues that appear in Exhibit 1009. Nevertheless, Patent Owner

opposes Petitioner's request and argues that the figures at issue were substantively relied on by Petitioner and were not corrected earlier in the proceeding, causing Patent Owner to be prejudiced by not having had the opportunity to substantively respond earlier with support from its expert.

In response, Petitioner argues there was no prejudice to Patent Owner as the primary figure relied on from Exhibit 1009, Figure 7, was reproduced in its entirety in the Petition. *See* Pet. 27. Petitioner also argues that, even in the truncated versions of the figures, the relevant parts of the figures are shown, a point Patent Owner disputed as to certain portions of the figures.

There is no dispute that Exhibit 1009, as filed, contains clerical errors in the formatting of figures appearing at pages 49 to 56. While we emphasize it is the responsibility of the party filing a paper or an exhibit to assure that it is correct as filed, and that steps should be taken to confirm that what is filed with the Board is properly formatted, we also recognize that clerical errors can occur. *See, e.g.*, 37 C.F.R. § 42.104 (permitting a motion to correct a clerical error in the petition).

Given that Figure 7 of the '095 Provisional was accurately reproduced in the Petition, which is the primary figure relevant to arguments of the Parties, and that Patent Owner had the opportunity to address the '095 Provisional in its Response, and may still address it (including any relevant differences in the versions) in its yet to be filed Sur-reply, we find speculative and unsupported the assertion that it will suffer any prejudice by allowing the filing of a corrected Exhibit 1009 at this stage of the proceeding to provide an accurate version of the '095 Provisional in the record of this proceeding. Accordingly, we authorize Petitioner to file an accurate copy of the '095 Provisional as a corrected Exhibit 1009, to be identified under the

same exhibit number with a notation that it is the corrected version.
Exhibit 1009, as originally filed, will also remain in the record.

III. LEAVE TO FILE MOTION TO STRIKE

Patent Owner seeks leave to file a motion to strike portions of Petitioner's Reply. In particular, Patent Owner identified in an email to the Board four portions of the Reply it contends raise new arguments or theories. *See* Exhibit 3001 (correspondence from Patent Owner identifying portions of the Reply it seeks to strike). Patent Owner acknowledges that the Petition presented grounds based on both anticipation and obviousness, but argues that, on a limitation-by-limitation basis, in certain instances the Petition only asserted an element was disclosed by the asserted reference, not that it would have been obvious over the asserted reference, as argued in the Reply.

Petitioner contends that the disputed arguments are routine reply arguments, that the Reply properly cites where the arguments were raised, and that the grounds of alleged unpatentability remain unchanged. According to Petitioner, its obviousness contentions in the Petition should not be read in isolation, but in the context of the entire ground to show why each limitation would have been obvious over the asserted prior art.

We find that Patent Owner has not sufficiently shown that leave to file a motion to strike is warranted under the circumstances presented. "In most cases, the Board is capable of identifying new issues or belatedly presented evidence when weighing the evidence at the close of trial, and disregarding any new issues or belatedly presented evidence that exceeds the proper

scope of reply or sur-reply.” Consolidated Trial Practice Guide¹, 80.
“[S]triking the entirety or a portion of a party’s brief is an exceptional remedy that the Board expects will be granted rarely.” *Id.* Rather than permit a motion to strike, we are entering as Exhibit 3001 to this proceeding the email submitted by Patent Owner as a record of the portions of the Reply it sought to strike, which we will take into consideration in reaching a final written decision. Patent Owner’s request for authorization to file a motion to strike is denied.

IV. ORDER

Upon consideration of the record before us, it is:

ORDERED that Petitioner’s request to file an accurate copy of the ’095 Provisional as a corrected version of Exhibit 1009 is *granted*; and

FURTHER ORDERED that Patent Owner’s request for authorization to file a motion to strike is *denied*.

¹ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

IPR2023-01289
Patent 10,032,171 B2

FOR PETITIONER:

Eliot D. Williams
Jennifer Tempesta
Baker Botts L.L.P
eliot.williams@bakerbotts.com
jennifer.tempesta@bakerbotts.com

FOR PATENT OWNER:

Seth Lindner
Brett Cooper
Robert A. Auchter
BC Law Group, P.C.
slindner@bc-lawgroup.com
bcooper@bc-lawgroup.com
robert@auchterlaw.com